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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,582	12/20/2001	Patrick Soon-Shiong	VIVOR1420-1 (073799-1107)	6249

7590

11/18/2002

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,582

Applicant(s)

SOON-SHIONG ET AL.

Examiner

D. L. Jones

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1616

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESTRICTION INTO GROUPS

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to a microcapsule, classified in class 424, subclass 489.
 - II. Claims 7-38, drawn to a microcapsule, classified in class 424, subclass 451.
 - III. Claims 39, drawn to a method of making a microcapsule, classified in class 428, subclass 402.2+.
 - IV. Claim 40, drawn to a method of making a macrocapsule, classified in class 428, subclass 321.5+.
 - V. Claims 41-46, drawn to a second method of making a microcapsule, classified in class 428, subclass 402.2+.
 - VI. Claims 47-52, drawn to a second method of making a macrocapsule, classified in class 428, subclass 321.5+.
 - VII. Claim 53, drawn to a microcapsule containing a cell aggregate, classified in class 424, subclass 520+.
 - VIII. Claim 54, drawn to a macrocapsule containing a cell aggregate, classified in class 424, subclass 520+.
 - IX. Claim 55, drawn to a second method of making a macrocapsule with containing a cell aggregate, classified in class 424, subclass 520+.
 - X. Claims 56-58, drawn to a method of making a microcapsule containing a cell aggregate, classified in class 424, subclass 520+.
 - XI. Claims 59-61, drawn to a method of making a macrocapsule containing a cell aggregate, classified in class 424, subclass 520+.

XII. Claims 62-64, drawn to a second method of making a macrocapsule containing a cell aggregate, classified in class 424, subclass 520+.

Note: Applicant is respectively requested to elect one product and one corresponding method of making that product for examination.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions (I & III), (I & V), (II & IV), (II & VI), (VII & X), (VIII & XI), (VIII & XII), (IX & XI), and (IX & XIII) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product may be made by materially different processes as set forth in claims 39-52 and 55-64.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

ELECTION OF SPECIES

4. Claims 1-64 are generic to a plurality of disclosed patentably distinct species comprising biologically active material which may be selected from the group consisting of living cells, biological materials, pharmacologically active drugs, and diagnostic

agents. In addition, it is noted that the living cells may be selected from the group consisting of pancreatic islet, tumor, human T-lymphoblastoid, islet of Langerhans, dopamine secreting, nerve growth factor, hepatocytes, adrenalin, angiotensin secreting, parathyroid, norepinephrine, or metencephalin secreting cells. Similarly, the pharmacologically active and diagnostic agents are unlimited. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Note: Applicant is respectfully requested to elect a specific single species (e.g., human T-lymphoblastoid cells) for examination purposes.

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was not made to request an oral election to the above restriction requirement due to the complexity of the restriction and/or election requirement.

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7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri. (alternate Mon.), 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose' Dees can be reached on (703) 308- 4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


D. L. Jones
Primary Examiner
Art Unit 1616

November 18, 2002